



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/964,415 | 09/28/2001 | Ibraheem Badejo | 108773 | 1494 |
| 27049 | 7590 | 10/02/2003 | EXAMINER | |
| OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320 | | | PATTEN, PATRICIA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1654 | |

DATE MAILED: 10/02/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,415

Applicant(s)

BADEJO ET AL.

Examiner

Patricia A Patten

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,9-17 and 32-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,18-31 and 67 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-67 are pending in the application.

Election/Restrictions

Applicant argues that Claims 7 and 8 should not have been withdrawn from consideration (p.14, Arguments). Applicant is correct. The withdrawing of these claims was an inadvertent error. Thus, these claims have been re-joined with the elected claims as these claims were originally examined on the merits and found free of the art (please also see 'Allowable Subject Matter' *infra*).

This application contains claims 9-17 and 32-66 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant has deleted the terms 'grape seed', 'grape skin' and 'grape extracts' from the claims. Because this was the second species which was searched in the prior art, a new species must be chosen to search. The Examiner has chosen the species of 'tea' for examination on the merits. Claims 4 and 5 which were previously examined on

Art Unit: 1654

the merits because they recited the species of 'grape seed', 'grape skin' or 'grape extracts' have now been withdrawn as being drawn to a non-elected invention because they do not contain the species of 'tea'.

Thus, claims 4-5, 9-17 and 32-66 have been withdrawn from consideration on the merits as being drawn to a non-elected invention. Because claim 67 is dependant upon claim 1, and because the claim is generic to all species of claim 1, this claim will be examined on the merits per the request of the Applicant (Remarks, Restriction Election (A)).

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

The amendment filed 7/10/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "Preferably, according to one embodiment of the present invention, a composition of this invention has from 65 to 99.9 weight % of monomer such as cyanoacrylate or blend of cyanoacrylates and is promoted to polymerize by 0.005 to 10 weight % of an initiator or accelerator".

Art Unit: 1654

Applicant contends that this information is supported by US 09/919,877 which was incorporated by reference into the Instant specification (p.14, Arguments).

The Examiner has determined that these specific embodiments which state a particular amount of monomer and a blend of cyanoacrylates which have particular polymerization properties is new matter. Applicant states on p.13 of the Instant specification that "Such alkyl ester cyanoacrylates and other suitable monomers are disclosed in, for example,the entire disclosures of which are incorporated herein by reference". Thus, the disclosure has referenced these patents for incorporation of specific cyanoacrylates and monomers which are suitable for the Instant invention, however does not contemplate any other specific embodiments from these patents with regard to weight percentage of the *Instantly claimed composition*, or a blend of cyanoacrylates which is promoted to polymerize by 0.005 to 10 weight % of an initiator or accelerator.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 67 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the language '...is present in an amount of from about 65 to about 99.9% by weight' does not find support in the Instant specification as filed. As indicated *supra*, although Applicant has incorporated several patents by reference into the Instant specification, these incorporations are not basis for the new language as recited in claim 67. Although US 09/919,877 was incorporated by reference in it's entirety into the Instant specification, the Examiner cannot conclude that Applicant considered these *particular* embodiments to be a critical feature of the invention. These features are considered particularly critical because they are found *in a claim*. The new citation of a specific embodiment in 09/919,877 does not constitute adequate *disclosure of that specific embodiment which pertains to the Instantly claimed invention*.

Applicant is asked to remove the new matter from the claim in order to overcome this rejection.

Claim Rejections - 35 USC § 102

Claims 1-3, 6, 18-21, 24, 25 and 28 remain rejected under 35 U.S.C. 102(b) as being anticipated by Miyami (US 3,507,822) as newly evidenced by Friedland et al. (US 4,828,113)*.

Applicants' arguments directed toward the species of grape extract are moot in light of the deletion of this species in the claims. Applicants' principal argument toward this rejection is that because the claims do not reflect tannic acid due to the deletion of grape extracts in the claims, that this rejection should fall. However, although these species were deleted, the claims remain anticipated by Miyami for the following reasons:

Tannic acid is found in grapes, however, is found in numerous other plants such as tea as evidenced by Friedland et al. (US 4,828,113)* (col.15, lines 9-14). The term 'extract' is broad. Further, according to the breadth of the claim which specifies that *particular* compounds such as resveratrol are 'extracts' of plant matter, the term 'extract' has been given this broad meaning which includes particular compounds from plant matter. Thus, tannic acid is deemed to be an 'extract' of tea because it is derived from tea.

Because tannic acid is an extract for tea, the claims remain rejected for the same reasoning set forth in the previous Office action: Miyami taught every limitation in these claims (please see previous Office action).

It is noted that in the previous Office Action, the Examiner incorrectly calculated the percentage of the tannic acid in the composition disclosed by Miyami. The calculation was performed as if the total amount of parts in the composition equaled 100. As seen in Example 3 of Miyami, the tannic acid is present at 0.2 parts per 130.7 parts. Therefore, the tannic acid was present at approximately 0.15%. Although the original calculation was skewed, this percentage nevertheless anticipates the percentage of stabilizer as recited in claims 20 and 21 because 0.15% falls within each respective range.

*This reference is used to relay an inherent property of tea, and is not used in the rejection *per se*.

Claim Rejections - 35 USC § 103

Claims 1-3, 6 and 18-28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Miyami (US 3,507,822).

Applicants' primary argument concerning this rejection is based upon the previous contention that the 102(b) over Miyami should fall because the claims 'no longer reflect tannic acid' (p.17-Arguments). However, as discussed *supra*, tannic acid is an extract from tea. Therefore, the teachings of Miyami obviate the claimed invention for the reasons set forth on the record (please see previous Office action).

It is reiterated that although Miyami specifically taught that sterilizing agents were combined with the composition if being used for medical purposes (col.3, lines 57-60). Therefore, one of ordinary skill in the art would have been motivated to have sterilized the composition for clinically treating wounds susceptible to infection.

Claims 1-3, 6 and 29-31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Miyami (US 3,507,822) in view of Papay (US 5,866,106).

Again, Applicants' primary argument concerning this rejection is based upon the previous contention that the 102(b) over Miyami should be removed because the claims 'no longer reflect tannic acid' (p.17-Arguments). However, as discussed *supra*, tannic acid is an 'extract' from tea. Therefore, the teachings of Miyami in view of Papay obviate the claimed invention for the reasons set forth on the record (please see previous Office action).

It is reiterated that the addition of an antioxidant stabilizer into the composition disclosed by Miyami would have been obvious in view of Papay because Papay taught the addition of antioxidants to cyanoacrylate bonding compositions in order to destroy free radicals (please see previous Office Action as well as Papay col.1, lines 12-21 and col.2, lines 15-32). One of ordinary skill in the art would have been motivated to have added an antioxidant such as pentamethylchromanol to a cyanoacrylate bonding

Art Unit: 1654

composition in order to prevent free radical formation, thereby decreasing the patient's risk of abnormal cell proliferation.

The Examiner deemed that pentamethylchromanol to be an obvious substitute for an antioxidant such as vitamin C, because pentamethylchromanol is also known as an antioxidant, or 'oxygen scavenger'. Because all antioxidants perform the same basic function of oxygen scavenging, it is deemed that the ordinary artisan would have recognized that pentamethylchromanol would have been a suitable antioxidant substitute, especially lacking evidence to the contrary. It is noted that Applicants have not provided any indication that pentamethylchromanol is superior to any of the antioxidants as disclosed by Papay.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Allowable Subject Matter

Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703) 308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

September 23, 2003

A handwritten signature in black ink, appearing to read 'Patricia Patten', with a large, stylized initial 'P'.

Patricia Patten